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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/736,293
Filing Date: December 16, 2003
Appellant(s): BANATWALA ET AL.

Steven M. Greenberg
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 5/16/2008 appealing from the Office action mailed 7/17/2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1- 2 and 4- 13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically the addition of the “computing platform” does not appear anywhere within the original specification. For the purposes of this examination the term “computing platform” will be given it’s broadest reasonable interpretation.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-2 and 4-13 are rejected under 35 U.S.C. 101 because the claims lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of

matter. As such, they fail to fall within a statutory category. They are, at best, functional descriptive material *per se*.

Descriptive material can be characterized as either “functional descriptive material” or “non-functional descriptive material.” Both types of “descriptive material” are non-statutory when claimed as descriptive material *per se*, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994)

Merely claiming non-functional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because “[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.”).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 1-2 and 4-13 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Fredell et al. (hereinafter Fredell), U.S. PGPUB NO.: US 2001/0028364 A1.

Fredell teaches:

Claim 1:

A discussion forum resource comprising (Par.108; reads on the limitation of a discussion forum): at least one topic thread disposed in the discussion resource forum and created for externally sourced content in the discussion forum resource (Figure 1 & Par. 2 & Par. 107), wherein said externally sourced content comprise postings from another discussion forum resource (Figure 1 & Par. 2 Lines 1-10 & Par. 122); and, a data aggregator executing in a computing platform and coupled to said at least one topic thread and configured to manage said externally sourced content in said at least one topic thread (Figure 1 & Par. 2 & Par.107).

Claim 2:

The discussion forum resource of claim 1, wherein said externally sourced content comprise data selected from the group consisting of text, audio, imagery and video (Figure 2 & 3 & Par. 43 Lines 11-15).

Claim 3:

Cancelled.

Claim 4:

The discussion forum resource of claim 1, wherein said data aggregator further comprises a configuration for writing responsive • postings in said at least one topic thread disposed in the discussion forum resource to said another discussion forum resource (Figure 1 & 4 & Par. 36 Lines 7-9 & Par. 37 Lines 9-13 & Par. 109 & Par. 107-110; reads on the limitation of alternate discussion forums and being able to write to them).

Claim 5:

A discussion forum management method comprising the steps of (Par.108; reads on the limitation of a discussion forum): receiving externally sourced data for posting in a discussion forum resource (Figure 1 & Par. 2 Lines 1-10 & Par. 122); creating a new topic thread for said externally sourced data (Figure 4 & Par. 114; reads on the limitation of new topic threads); and, responsively posting to said externally sourced data in said new topic thread (Par. 110).

Claim 6:

The method of claim 5, further comprising the steps of: determining whether subsequently received postings are responsive postings which relate to said externally sourced data; and, posting said subsequently received postings to said external data source if it is determined that said subsequently received postings are responsive postings which relate to said externally sourced data (Par. 11 Lines 5-20 & Par.110; it is inherent that in order for the invention to

provide notifications when a response is issued it would have to be able to determine whether the received posting is a responsive posting or not).

Claim 7:

The method of claim 5, wherein said externally sourced data comprises data selected from the group consisting of text, audio, imagery and video (Figure 2 & 3 & Par. 43 Lines 11-15).

Claim 8:

The method of claim 5, wherein said externally sourced data comprises postings for another discussion forum resource (Figure 4 & Par. 36 Lines 7-9 & Par. 37 Lines 9-13 & Par. 109; reads on the limitation of alternate discussion forums).

Claim 9:

A machine readable storage having stored thereon a computer program for discussion forum management (Par.108; reads on the limitation of a discussion forum), the computer program comprising a routine set of instructions which when executed by a machine cause the machine to perform the steps of: receiving externally sourced data for posting in a discussion f resource (Figure 1 & Par. 2 Lines 1-10 & Par. 122); creating a new topic thread for said externally sourced data (Figure 4 & Par. 114; reads on the limitation of new topic threads); and, responsively posting to said externally sourced data in said new topic thread (Par. 110).

Claim 10:

The machine readable storage of claim 9, further comprising the steps of: determining whether subsequently received postings are responsive postings which relate to said externally sourced data; and, posting said subsequently received postings to said external data source if it is determined that said subsequently received postings are responsive postings which relate to said externally sourced data (Par. 11 Lines 5-20 & Par.110; it is inherent that in order for the invention to provide notifications when a response is issued it would have to be able to determine whether the received posting is a responsive posting or not).

Claim 11:

The machine readable storage of claim 9, wherein said externally sourced data comprises data selected from the group consisting of text, audio, imagery and video (Figure 2 & 3 & Par. 43 Lines 11-15).

Claim 12:

The machine readable storage of claim 9, wherein Said externally sourced data comprises postings for another discussion forum resource (Figure 4 & Par. 36 Lines 7-9 & Par. 37 Lines 9-13 & Par. 109; reads on the limitation of alternate discussion forums).

Claim 13:

A collaborative environment configured to include external data sources in a discussion forum resource comprising: at least two discussion forum resources coupled to each other (Figure 4 & Par. 36 Lines 7-9 & Par. 37 Lines 9-13 & Par.

109; reads on the limitation of alternate/multiple discussion forums); and, a data aggregator executing in a computer platform and disposed between said at least two discussion forum resources (Figure 1 & Par. 114; reads on the limitation of there being a data aggregator) and configured to synchronize postings related to one another in said at least two discussion forum resources (Par. 110 & 120 & 121; the limitation of synchronization is inherent when notifications are made available upon cue).

(10) Response to Argument

Appellant's arguments filed have been fully considered but they are not persuasive. In substance, the appellant argues 1) that claims 1, 2, 4 and 13 fall under a statutory category; 2) that **Fredell** does not teach or disclose externally sourced content that comprises postings from another discussion forum resource as required by claim 1; 3) Fredell does not teach the concept of two different discussion forum resources along with the concept of synchronizing postings between two different discussion forum resources as required by claim 13; 4) there is ample support for the equivalence of a *computing platform* in Figure 1.

In response to 1), the Examiner respectfully disagrees. Claims 1 (and its dependents 2 and 4) reads, a discussion forum resource comprising: a topic thread and a data aggregator, all of which are interpreted as being software hence lacking a hardware component. In order for a claim to fall within a statutory category there would have to be necessary physical articles or objects to constitute a machine or a manufacture. The same rationale applies to claim 13; therefore the claims fail in

possessing a physical component to constitute a machine or a manufacture rendering them non-statutory under U.S.C. § 101.

In response to 2) & 3), **claims 1- 2, 4 and 13** recite language such as “adapted to” or ‘configured to”. These terminologies render the claim indefinite as the scope of the claim becomes open ended, undeterminable, and/or based upon intended use. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitations.

It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The following are examples of language that may raise a question as to the limiting effect of the language in a claim:

(A) statements of intended use or field of use,

(B) “adapted to” or “adapted for” clauses,

(C) “wherein” clauses, or

(D) “whereby” clauses

(E) “configured to” clauses.

This list of examples is not intended to be exhaustive. See also MPEP § 2111.04. USPTO personnel are to give claims their broadest reasonable interpretation in light of the supporting disclosure. In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023,

1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim are not read into the claim. E-Pass Techs., Inc. v. 3Com Corp., 343 F.3d 1364, 1369, 67 USPQ2d 1947, 1950 (Fed. Cir. 2003) (claims must be interpreted "in view of the specification" without importing limitations from the specification into the claims unnecessarily). In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550551 (CCPA 1969). See also In re Zletz, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) ("During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow.... The reason is simply that during patent prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed.... An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process.").

Furthermore, even if **claims 1- 2, 4 and 13** do not recite intended use language the Examiner respectfully disagrees that **Fredell** does not disclose those limitations. The appellant uses the terms *discussion forum resource* (and not a discussion forum), therefore **Fredell**, discloses this limitation through: "FIG. 4 shows an exemplary web page 100 including a plurality of clickable icons [*discussion forum resources*], e.g., icons 101-106 representative of functionality provided by the system. Web page 100 further includes a user navigator window 108 including a plurality of clickable hyperlinks [*discussion forum resource which could be a reference to another document in a different/external domain*] 110. Icon 101 provides access to an on-line "Document Vault"

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that allows for providing immediate access to the latest draft of documentation, memoranda, etc., to participants regardless of their physical location across the world. (Par. 88)” Additionally, **Fredell** discloses an *attachment selector*, for attaching other different documents that could be related to the specific task (*thread*) at hand, and a *notification selector*, for notifying a participant via E-mail [which by it self could be considered a separate discussion forum resource] or any other communications means (Par. 93); along with postings from new documents (Par. 95). Therefore, **Fredell** teaches the limitation of an externally sourced content comprising postings from another discussion forum resource because the clickable icons and hyperlinks are references to an external domain and so the rejection of **claims 1-2, 4 and 13** should be affirmed. Similar arguments apply to **claims 5 and 9** therefore those rejections should also be affirmed.

Specifically regarding **claim 13**, even if intended use language was not recited the Examiner respectfully disagrees that **Fredell** does not teach the limitations. **Fredell** discloses different discussion forum resources through clickable icons/hyperlinks, and posted snap shots (Par. 88 & 95). Furthermore, **Fredell** discloses the concept of synchronizing these postings through: allocating a respective *time window* for the respective task; through a *datafield* for assigning a criticality level to the task (i.e. has the task been started or is in process or completed etc.); through a *clickable edit icon* (i.e. for updating and informing changes to a task, changes to criticality levels or time windows) and updating, *synchronizing*, the web page through posted snap shots of new, *different*, documents (Par. 95).

In response to 4), the Examiner respectfully disagrees. The term *computing platform* has multiple common definitions in the technology (i.e. operating system) and Figure 1 fails to provide support for the equivalence of such a meaning. Therefore, the term computing platform still constitutes new matter and the U.S.C. § 112, first paragraph rejection should be affirmed.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

M.A. 7/14/2008

/William C. Vaughn, Jr./

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